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116/09

In re Application of:
RAY, EDDIE F. III et al.
Serial No.: 10/766,504
Filed: Jan. 27, 2004
Docket: 03190.000100.
Title: BONE GRAFTS

DECISION ON PETITION

This is a decision on the petition filed on Dec. 4, 2008 by which petitioner requests reconsideration and withdrawal of the restriction requirement mailed Dec. 13, 2007 and that all non-elected claims be rejoined and examined on the merits along with the elected claims. This petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is **DISMISSED**.

A review of the record reveals that a restriction requirement was made between three disclosed and claimed related inventions: (I) Claims 1-15, 19-46, and 50-66 drawn to a bone allograft, classified in class 623, subclass 17.11. (II) Claims 16, 18, 47, and 49, drawn to a method for restoring vertical support, classified in class 606, subclass 61, and (III) Claims 17, 18, 48, and 49, drawn to a method of making an allograft, classified in class 623, subclass 23.61. In addition, the examiner required an election of species between the embodiments represented by Figures 1-36. The examiner alleged that there are twenty species, namely, Species A. Figure 1; B. Figures 3-4; C. Figures 5-6 ; D. Figures 7-8 ; E. Figure 11 ; F. Figure 12; G. Figure 13 ; H. Figures 14-17 ; I. Figure 18 ; J. Figures 19-20 ; K. Figure 21 ; L. Figure 22 ; M. Figure 23 ; N. Figures 24-25 ; O. Figure 26 ; P. Figure 27; Q. Figure 28 ; R. Figure 29 ; S. Figures 30-32 and T. Figures 33-36.

In judging the propriety of the restriction requirement, the related inventions, as claimed, must be shown to be distinct. See MPEP 802.01. The inventions I and II are related as product and process of use and can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the examiner stated that the Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be

made by another and materially different process (MPEP § 806.05(f)). In the instant case, the examiner stated that the process as claimed can be used to make another and materially different product. Inventions II and III are directed to related processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the examiner stated that the inventions as claimed have a materially different design, mode of operation, function, or effect. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

In the instant application, the distinctness between the claimed inventions was justified in that the process for using the product as claimed can be practiced with another materially different product and the process as claimed can be used to make another and materially different product. The inventions as claimed in Group II and III do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Furthermore, as part of any restriction requirement, the search and examination for each of these three claimed inventions and various distinct species must be considered a serious burden on the examiner if restriction were not required. See MPEP 803 and 808.02. Aside from the different classifications indicated in the requirement, the search for the process claims would involve a search in areas such as where restoring vertical support are found, for example in Classes 623, 606, 604, etc. which are diverse from the search for the product claims.

Petitioner traverses the examiner's rationale of the restriction by basically arguing that the claims were copied from another patent for interferences purposes. Essentially, petitioner argues that by maintaining the restriction the applicant would have to file additional applications which would be unnecessarily inefficient, cumbersome and undesirable to both the Examiner and the Board of Patent Appeals and Interferences. Petitioner also believes that the path of prosecution likely to be most efficient to the USPTO and cost effective to the parties, and therefore the least burdensome to all, is to examine all three groups of claims in the subject application together, rather than separately. This line of arguments is not persuasive to overcome the restriction requirement. Petitioner failed to present arguments as to why the separate Inventions I, II and III and various species are not patentably independent or distinct. There are no arguments presented as to why the species are not mutually exclusive.

Finally, petitioner argues that if additional applications are to be filed, efforts of the Board of Patent Appeals and Interferences would be expanded two or three times compared to prosecution of a single interference. Therefore such possible multiple contested proceedings will consume far more resources of the PTO and the parties than would a single examination of the subject application now. This line of arguments is also not persuasive because should the copied claims ultimately become allowable, the potential interferences with Ford patent still may be grouped together by the Board of Patent Appeals and Interferences, if desirable.

Conclusion

For the reasons outlined above, the restriction requirement promulgated in the restriction requirement dated Dec. 13, 2007 is in accordance with proper Office procedure. Therefore, the examiner's restriction requirement is proper.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3733 for further consideration of the applicant's response filed on Dec. 4, 2008. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

The petition is DISMISSED.



Donald T. Hajec, Director
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